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REMARKS

The Office Action mailed January 15, 2002, has been carefully studied and reviewed. In response, Applicant cancels claims 1-19 without prejudice, and adds new claims 20-38 without adding new matter. Further, all new claims are supported by the specification as filed.

The present invention relates to a method where a medical care provider, such as a doctor, prescribes a medical product for a patient that is purchased through a website associated with the medical care provider and wherein the same medical care provider receives compensation or revenue based on the sale of the prescribed product. The sale of the prescribed medical product is consummated over the Internet and one or more of the transactions associated with the sale utilizes the medical care provider's website. The prescribing medical care provider's website is communicatively linked to an e-commerce provider and one or more medical supply vendors. The patient receiving the prescription may access the website, and follow one or more links to order the appropriate prescribed medical supply from the medical supply vendor. Further, the patient remits payment to the e-commerce provider. Subsequently, compensation for the sale of the prescribed medical supply is realized by the medical care provider, the e-commerce provider, and the medical supply vendor. Therefore, the medical care provider becomes an essential part of the entire process through participation in the sale of the prescribed medical supply.

It is important to note that the medical care provider prescribes a medical supply to a patient. Further, as defined on page 4 of the specification, lines 3-4, to "prescribe" means to designate or order (i.e. a doctor's order) the use a specific medical supply as a remedy." In many cases, the prescription, order or direction will result from an actual examination or diagnosis. However, in other cases, the prescription, order or direction may simply result from knowledge that the medical care provider has relating to the

patient. Therefore, the phrase “resulting from a medical examination” or similar language simply means that the medical care provider has in his or her possession information relating to the patient that is sufficient to warrant a prescription, order or direction with respect to a medical product.

Turning now to the cited art, Silver discloses an interactive wellness system that collects information relating to a user’s “voluntary choices, habits, environment, disease transactions, and genetic dispositions” (see column 4, lines 49-52). In Silver, a user may access a computer program and answer a host of predetermined questions regarding the voluntary lifestyle choices made by the user. Considering the user’s answers, the computer program accesses a knowledge base and presents the user with a list of personalized options. The user may then review the options to determine what effect implementing the personalized options would have on the user’s short or long term health. The user can continue to select various personalized options in this manner until the user determines a personalized wellness plan that he or she would like to implement. However, contrary to the Examiner’s conclusions in the Office Action, Silver fails to teach or suggest Applicant’s invention.

Silver fails to disclose a medical care provider that prescribes a medical supply or product. The system and method of Silver has nothing to do whatsoever with a prescription, order, or direction by a doctor or medical care provider after an examination and diagnosis. In fact, Silver actually teaches away from prescribing by allowing the system to collect the information, analyze the input, and decide a suitable course of action based on guidelines, as opposed to an examination and diagnosis by the medical care provider (see column 6 of Silver, lines 1-8). In short, there is nothing in Silver to suggest that the physician prescribes anything for the patient resulting from an examination. In contrast, the machine makes a recommendation based on a set of predetermined guidelines. A machine is not a medical care provider, and therefore, is

incapable of “prescribing” a medical product or supply as defined by Applicant. Further, a machine that is able to recommend “canned” options by analyzing a set of predetermined guidelines does not satisfy Applicant’s definition of what it means to “prescribe.”

Further, Silver fails to teach or suggest a medical care provider actually receiving compensation for the sale of the prescribed medical supply. Applicant notes that the system and method of Silver may provide links to a vendor, however, there no indication whatsoever that the attending physician or anyone sponsoring a website receives any compensation for the sale of a prescribed medical supply. At best, the system and method of Silver is a resource center to assist users in locating information regarding the wellness options they have chosen.

Moreover, Silver does not disclose an e-commerce provider to secure payment when the patient buys a prescribed medical supply. In fact, Silver never mentions this. A close reading of the Silver disclosure fails to reveal the participation of an e-commerce provider, and further, fails to reveal any party accounting to the medical care provider, such that the medical care provider is compensated for the sale of the prescribed medical supply.

With respect to new claims 20-38, independent claim 20 requires “selecting the prescribed medical supply from the list of medical supplies on the website...[and] the e-commerce provider crediting accounts associated with... the medical care provider.” As stated above, the system and method of Silver is incapable of prescribing anything, and Silver never discloses an e-commerce provider providing compensation to the prescribing medical care provider. Independent claim 20 defines patentable subject matter over the cited art. Accordingly, Applicant respectfully requests the allowance of independent claim 20, and its dependent claims 21-31.

Independent claim 32 explicitly requires "prescribing a medical supply by a medical care provider...[and] consummating the transaction...through an e-commerce provider...[and] accounting for the transaction to the medical care provider such that the medical care provider receives, directly or indirectly, compensation for the transaction."

For the reasons stated above, Silver fails to teach or suggest these requirements of claim 32. As such, Applicant submits that independent claim 32 defines patentable subject matter over the cited art. Accordingly, Applicant respectfully requests the allowance of claim 32, and its dependent claims 33-38.

The Examiner has rejected certain former claims under 35 U.S.C. 103(a) as being unpatentable over Silver. While the former claims have been cancelled herein without prejudice, there may still be some overlapment of the subject matter recited in the former claims and the new claims submitted herewith. For that reason, a few comments may be in order concerning the 35 U.S.C. 103(a) rejection.

Fundamentally, the patent office has failed to make out a prima facie case of obviousness in each case where there is a Section 103 rejection. Since the Examiner relied on one single reference, the patent to Silver, the obviousness rejection is based on modifying Silver based on what the Examiner considers to be admissions of prior art or prior art established through the mechanism of official notice. However, in all cases, it is fundamental that the Examiner, for each claim, must articulate a motivation for combining, altering or modifying the prior art. In many cases in the patent office's obviousness rejection, there is simply a conclusion that it would have been obvious to perform certain functions or methods without any explanation of why a person of ordinary skill in the art would be motivated to alter Silver in the first place. Therefore, none of the obviousness rejections, as a matter of law, establish a prima facie case of obviousness.

Indeed, Applicant's invention is far removed from the basic teachings of Silver for the reasons that have already been articulated above. There is no motivation to combine any prior art with Silver so as to turn Silver into a case where there is a prescribing medical care provider that not only prescribes a medical supply or a medical product but also provides access for his or her patients to order the prescribed supply or product through the Internet via a website associated with the same prescribing doctor or medical care provider. Added to that, is the feature of the present invention where the sale of the prescribed medical supply or product is a part of a business enterprise that the doctor or the medical care provider is involved in, and where that same prescribing doctor or medical care provider receives compensation or revenue from the very sales of medical products or supplies that he or she prescribed. In short, there is no motivation to alter the Silver disclosure. Any motivation that is articulated here is simply based on reconstructing Applicant's invention through hindsight.

The Examiner notes that Silver does not disclose the process of having a physician accept payment for a product and be debited for some or all of the payment provided by the patient. However, the Examiner takes official notice that this process is very well known and is commonly used in the practice of opticians and podiatrists. The Examiner is specifically requested to come forward with proof that such a process is old and well-known. In addition, the Examiner takes the position that the use of an e-commerce provider in a system or process similar to Silver or the present invention is old and well-known. The Examiner is specifically requested to come forward with proof of such. In fact, the patent office is respectfully requested to come forward with proof of all prior art that the Examiner relies on through official notice.

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